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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**



In the matter of Application Serial No. 75/845,350, INTELLIWEAR  
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U.S. Patent &amp; TMO/c/TM Mail Rcpt Dt. #70

MARK D. TANNEN,

Opposer,

Opposition No. 91151109

V.

JAY MACK,

Applicant.

**OPPOSER'S RESPONSE TO APPLICANT'S OBJECTION TO  
DECLARATION OF PAUL J. REILLY FILED NOVEMBER 20, 2002**

Opposer, Mark D. Tannen ("Opposer"), respectfully submits this response to Applicant, Jay Mack's (hereinafter "Applicant") objection to the Declaration of Paul J. Reilly filed on November 20, 2002 which concerns the Board's order dismissing with prejudice the petition to cancel in the matter of *Intelliware Systems, Inc. v. Mark D. Tannan*, Cancellation No. 31,660. Contrary to Applicant's assertions, Opposer is aware of the Board's procedures and strives to follow them. Opposer submitted the Declaration of Paul J. Reilly to apprise the Board of the dismissal of Cancellation No. 31,660, a proceeding on which Applicant previously relied to support its motion to dismiss or for summary judgment, so that the Board may make a full and fair determination of this matter on the merits. Applicant, now contesting the Declaration of Paul J. Reilly, would rather that the Board not learn of this dismissal. For the reasons discussed herein, Paul Reilly's declaration and the Board's order attached thereto should be considered in this matter.

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**I. Submission of New Evidence**

Specifically, in support of its Motion to Dismiss Opposition for Lack of Subject Matter Jurisdiction, or In the Alternative for Summary Judgment ("Motion to Dismiss"), Applicant referenced the matter of *Intelliware Systems, Inc. v. Mark D. Tannen*, Cancellation No. 31,660, in which Intelliware Systems' petition alleged that Mark D. Tannen, Opposer herein, abandoned the mark AI AMERICAN INTELLIWARE and Design (Reg. No. 1,347,429). In that proceeding, Mr. Tannen submitted with his answer evidence of his use of the mark AI AMERICAN INTELLIWARE and Design. On March 7, 2002, Opposer moved to dismiss that proceeding under Trademark Rule 2.132 in view of Intelliware Systems' failure to take testimony or offer any evidence. On September 10, 2002, the Board dismissed Intelliware Systems' petition for cancellation with prejudice.

However, it was not until November 20, 2002 that Opposer's attorneys of record in that matter, Baker Botts LLP, received the Board's order. Accordingly, Opposer had no prior opportunity to inform the Board of this order which is relevant to the issues presented by Applicant's Motion to Dismiss.

Opposer does not dispute that Trademark Rule 2.127(a) states that other than a motion, an opposition thereto and a reply, "[n]o further papers in support of or in opposition to a motion will be considered by the Board." However, it was prudent to inform the Board immediately of this new evidence so that the Board would know the true status of Cancellation No. 31,660 before rendering its decision on the Motion to Dismiss.

Opposer respectfully submits that the Declaration of Paul J. Reilly filed on November 20, 2002 was appropriate in the circumstances of this case and should be considered.

**II. Opposer's Declaration Does Not Contain A "False" Statement**

Contrary to Applicant's objection, the Declaration of Paul J. Reilly contains a statement based on his review of the Board's September 10th Order dismissing the petition to cancel with prejudice in the matter of *Intelliware Systems, Inc. v. Mark D. Tannen*, Cancellation No. 31,660. Specifically, Opposer's counsel drew the following inference from his review of the Order: "It is reasonable to conclude that Opposer's evidence of use of the mark AI AMERICAN INTELLIWARE and Design was sufficient for Intelliware Systems' to forgo pursuing its claim of abandonment against Opposer." The statement is not unfounded.

Unless the court in its order for dismissal otherwise specifies, a dismissal for failure of the plaintiff to prosecute "operates as an adjudication upon the merits." See Rule 41(b) of the Federal Rules of Civil Procedure; Marc A. Bergsman, 80 TMR 540, "Tips from the TTAB" (1990); Gambocz v. Yelencsics, 468 F.2d 837, 840 (3rd Cir. 1972) (holding that "[d]ismissal with prejudice constitutes an adjudication on the merits as fully and completely as if the order had been entered after trial.") (citing Lawlor v. National Screen Serv. Corp., 349 U.S. 322, 327, 75 S.Ct. 865, 868, 99 L.Ed. 1122 (1955)).

In his Answer to the Petition to Cancel in Cancellation No. 31,660, Mr. Tannen asserted three affirmative defenses: (i) that he continuously used the mark AI AMERICAN INTELLIWARE and Design in commerce; (ii) that he never had an intent to abandon the mark; and (iii) that he had not abandoned the mark. In support of his affirmative defenses, Mr. Tannen also submitted with his Answer evidence showing his continuous use of the mark AI AMERICAN INTELLIWARE and Design. When Intelliware Systems never took any testimony or offered any evidence, Mr. Tannen moved for involuntary dismissal on March 7, 2002 based on Intelliware Systems' failure to prosecute. Intelliware Systems never contested the motion.

Nor did it present any good or sufficient cause as to why judgment should not be rendered against it.

Thus, by its September 10, 2002 order dismissing the petition to cancel, the Board essentially made a finding, uncontested by Intelliware Systems, that Mr. Tannen, the Opposer herein, had not abandon his mark AI AMERICAN INTELLIWARE and Design which is the subject of Registration No. 1,347,429. Certainly, Mr. Tannen's evidence was sufficient for the Board, in its discretion, to dismiss the proceeding with prejudice and bar Intelliware Systems from petitioning to cancel Mr. Tannen's registration on grounds of abandonment. Accordingly, Opposer's attorney drew a reasonable inference which Applicant now contests by means of a Declaration that is not based on personal knowledge and contains unfounded opinion as to the Mr. Tannen's intent and use of the mark AI AMERICAN INTELLIWARE and Design.

In view of the foregoing, it cannot be said that by virtue of the Declaration submitted in support of Applicant's objection that the Declaration of Paul J. Reilly is "false" or not based on his reading of the Board September 10, 2002 Order in Cancellation No. 31,660.

### **III. Withdrawal of Statements In The Declaration**

While the parties may dispute the inference drawn by Opposer's counsel from the Board's September 10, 2002 Order, that dispute is not as imperative as keeping the Board informed of pertinent facts and getting to the merits of this case. Accordingly, Opposer shall withdraw the following statement from the Declaration of Paul J. Reilly: "It is reasonable to conclude that Opposer's evidence of use of the mark AI AMERICAN INTELLIWARE and Design was sufficient for Intelliware Systems' to forgo pursuing its claim of abandonment against Opposer." This should moot the issue raised by Applicant's objection and avoid any further burden to the Board in this regard.


**CONCLUSION**

In view of the foregoing, Applicant respectfully requests that the Board consider the Declaration of Paul J. Reilly with the exception of the statement withdrawn above or at the very least the consider the September 10, 2002 Order issued by the Board in Cancellation No. 31,660.

Respectfully submitted,

BAKER BOTTS LLP

Dated: December 26, 2002

By:   
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**CERTIFICATE OF MAIL AND SERVICE**

I hereby certify that the foregoing, OPPOSER'S RESPONSE TO APPLICANT'S OBJECTION TO DECLARATION OF PAUL J. REILLY FILED NOVEMBER 20, 2002 was deposited with the United States Postal Service "Express Mail Post Office To Addressee Service" in an envelope with sufficient postage, addressed to:

Box TTAB NO FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

and a true and correct copy of the foregoing was served on Applicant's attorneys of record via the United States Postal Service as First Class Mail, in an envelope with sufficient postage, addressed to following:

Robert T. Daunt, Esq.  
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DAVIS & SCHROEDER  
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on December 26, 2002.

By:   
Paul J. Reilly